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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,073	04/19/2000	Adam Coyle	06042-0145	3055

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<h1>Office Action Summary</h1>	Application <u>09/552073</u>	Applicant(s) <u>Norton</u> HV	
	Examiner <u>Akers, G</u>	Art Unit <u>3624</u>	Confirmation No.

- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/16/03
- ☒ This action is FINAL. ☐ This action is non-final.
- ☐ Since this application is in condition for allowance except for the formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in this application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-25 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved or ☐ disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.
- ☐ The drawing(s) filed on _____ is/are ☐ accepted or ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d) or (f).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received:
- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- ☐ The translation of the foreign language provisional application has been received.
- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Response to Amendment

1. This action is issued in response to applicant's Amendment A(Paper #10) filed 4/16/03.
2. No claims were deleted. New claims 22-25 were added. Independent claims 1,10,13,19 were amended.
3. Claims 1-25 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 USC 103(a) as unpatentable over Downing(US Pat. No: 5,963,647) in view of Jennings(US Pat. No:5,825,003) and further in view of First Data Corporation(1996).
6. As per claim 1 Downing teaches a method of issuing a negotiable instrument to an individual comprising detecting a direct deposit of funds into a first account of an individual and maintained by a first entity and transferring the funds unto a second account (Abstract)(Fig 5A).Downing fails to teach detecting a request by an individual for the issuance of a requested negotiable instrument having a value. Jennings teaches this(Abstract)(col 3 line 51-col 4 line

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27)as well as determining that the value of the requested negotiable instrument is not in excess of the second account(Fig 5/88) and authorizing the issuance of the requested negotiable instrument(Fig 5/86/96/84) and debiting the second account by the amount of the instrument(Fig 6)(Fig 9).It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Jennings to teach the above. The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by Jennings(col 2 lines 27-35).First Data Corporation through its subsidiary Western Union Financial Services, and Telecheck(Page 1)teaches automatic sweeping of funds into a second account from a first account with no individual name.The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by First Data.

7. As per claims 2,8,14 Downing teaches the method of claims 1,13 respectively detecting the direct deposit of funds into the first account and detecting a credit in the first account and wherein automatically transferring the total amount of the funds for direct deposit of funds into the into the second account comprises posting a debit in the first account and a credit in the second account(Fig 5B/S11)(Fig 6A/S115)(col 10 line 64-col 12 line 5).

8. As per claims 3,15 Downing teaches the method of claim 1,13. Downing does not specifically teach wherein the first entity is subject to federal banking regulations and wherein the second entity is not. Jennings teaches this(col 2 lines 37-56)(Fig 6/212/214/216/218).It would have been obvious to one skilled in the art at the time of the invention to combine Downing in

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view of Jennings to teach the above. The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by Jennings(col 2 lines 27-35).

9. As per claims 4,16 Downing teaches the method of claims 3,13 respectively. Downing does not specifically teach wherein the first entity is a bank and wherein the second entity is a licensed money transmitter. Jennings teaches this(Abstract)(Fig 1)(Fig 5)(Fig 7).It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Jennings to teach the above. The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by Jennings(col 2 lines 27-35).

10. As per claims 5,6 Downing teaches according to the method of claim 1. Downing does not specifically teach determining the value of the requested negotiable instrument is not in excess of the balance of the second account comprises determining that the value of the requested negotiable instrument plus any fees charged to the individual is not in excess of the balance of the second account. Jennings teaches this(Fig 13/818) as well as determining that the value of the requested negotiable instrument is not in excess of the second account(Fig 12) and authorizing the issuance of the requested negotiable instrument(Fig 14) and debiting the second account by the amount of the instrument(Fig 6).It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Jennings to teach the above. The

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motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by Jennings(col 2 lines 27-35).

11. As per claim 7 Downing teaches the method of claim 6. Downing does not specifically teach wherein determining that the aggregate value of the requested multiple negotiable instruments is not in excess of the balance of the second account and comprises determining that the aggregate value of the requested multiple negotiable instruments plus any fees charged to the individual that is not in excess of the balance of the second account..Jennings teaches this(Fig 12/722/726/738/734)as well as determining that the value of the requested negotiable instrument is not in excess of the second account(Fig 13/822/828/824) and authorizing the issuance of the requested negotiable instrument(Fig 14) and debiting the second account by the amount of the instrument(Fig 6/222/224).It would have been obvious to one skilled in the art at the time of the invention to combine Downing in view of Jennings to teach the above. The motivation to combine is to teach a method of transferring funds for customers domestically and internationally as enunciated by Jennings(col 2 lines 27-35).

12. As per claim 9 Downing teaches the method of claim 1 wherein determining the value of the requested negotiable instrument is not in excess of the balance of the second account comprises receiving an account number and a PIN number(col 6 lines 9-34) and determining that the account number identifies the second account(col 6 lines 59-65) and determining that the PIN number identifies the individual as being authorized to access the account(col 6 lines 18-21) and

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comparing the value of the requested negotiable instrument to the balance in the second account(col 6 lines 47-53).

13. Claim 10 is rejected under the same rationale as delineated in claims 9 and 1 above.

14. As per claim 11 Downing teaches the method of claim 10 further comprising cashing the negotiable instrument(col 5 lines 34-46)(col 7 lines 22-28).

15. Claim 12 is rejected under the same rationale as delineated in claims 8 and 1 above.

16. Claim 13 is rejected under the same rationale as claim 1 and in combination with Downing also teaching a POS terminal(CAT)(Fig 2/6/12).

17. Claim 17 is rejected under the same rationale as claims 1 and 2 and in combination with Downing also teaching a POS terminal(CAT)(Fig 2/6/12).

18. Claim 18 is rejected under the same rationale as claim 9 and in combination with Downing also teaching a POS terminal(CAT)(Fig 2/6/12).

19. Claim 19 is rejected under the same rationale as claim 9 and determining that the account number identifies the second account(col 6 lines 59-65) providing the requisite anonymity.

20. Claim 20 is rejected under the same rationale as claims 9 and 1 as delineated above.

21. Claim 21 is rejected under the same rationale as claims 3 and 4 delineated above.

Response to Arguments

22. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the necessitated additional ground(s) of rejection.

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Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the


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status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA


June 10, 2003

DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER